

Remarks

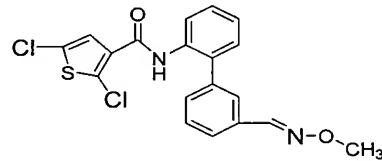
Upon entry of the foregoing amendment, claims 1-17 are pending in the application, with claims 1 and 8-11 being the independent claims. Claims 3 and 5-11 are withdrawn from consideration by the Examiner. New claims 12-17 are sought to be added. Support for new claims 12-17 can be found in the originally filed claims and through out the specification (*see e.g.*, the specification at page 73, Example 1). These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

I. Rejection under 35 U.S.C. § 103(a)

Claims 1, 2 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO02/08197, which is equivalent to U.S. Patent No. 7,176,228 B2 ("the '228 patent"). Applicants respectfully traverse the rejection.

The Examiner has stated that the '228 patent discloses a prior art compound:



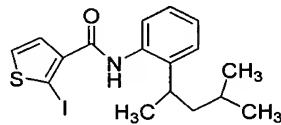
The Examiner has also alleged that:

The compound of the prior art differs from Applicant's compound in the substitution of chloro instead of hydrogen in the 5-position of thiophene. In the previous action it was explained that US Patent 7,176,228 B2 recites preferred substitutions on the

thiophene ring and that the patent discloses hydrogen in the 5-position of thiophene. Now, the difference between the prior art and Applicant's compounds is that the prior art compound has a methyl instead of an ethyl, propyl, butyl (longer alkyl chains) or hydrogen in the oxygen of the oxime group (new limitation). Therefore, the claimed invention differs from the prior art only by a methyl (or longer alkyl chain).

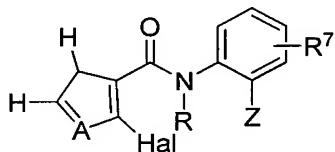
(Office Action, pages 2 and 3.)

Solely to expedite prosecution of the application, and not in acquiescence with the Examiner's assertion, claims 1 and 2 have been amended to delete the language that W¹ represents "the grouping -C(Q¹)=N-Q² in which. . ." Accordingly, the present claims 1, 2, 4 and 12-17 are directed to 2-Halofuryl/thienyl-3-carboxamides of the formula (I), which are structurally different from the alleged prior art compound disclosed in the '228 patent. Specifically, the present claims 1, 2, 4 and 12-17 are directed to 2-Halofuryl/thienyl-3-carboxamides of the formula (I) as represented by the elected compound N-[2-(1,3-dimethylbutyl)phenyl]-2-iodothiophene-3-carboxamide:

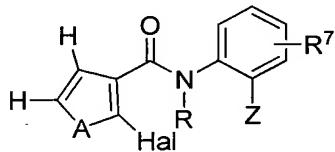


Based on the forgoing amendments to claims 1 and 2, the present claims 1, 2, 4 and 12-17 claims are not *prima facie* obvious over the '228 patent. Applicants respectfully request that this rejection be reconsidered and withdrawn.

On pages 3-5 of the Office Action, the Examiner notes that the structure set forth in Applicants' previous reply was inaccurate:



The correct structure should have been:



Applicants thank the Examiner for bringing this inadvertent error to their attention.

II. Nonstatutory Double Patenting Rejections

A. Double Patenting Rejection over U.S. Patent No. 7,208,169

Claims 1, 2 and 4 are rejected on the ground of non-statutory double patenting over claims 1-4 and 7-8 of U.S. Patent No. 7,208,169 B2 ("the '169 patent"). Applicants respectfully traverse the rejection.

The Examiner has asserted that:

[T]he structure of instant claim 1 is unpatentable over the structure of the '169 patent because the instant claims encompass overlapping subject matter as follows: A represents S (Sulfur) or O (oxygen); M represents phenyl and wherein Z is Z1 and Z1 represents phenyl substituted with W1, wherein W1 represents "doubly attached dioxyalkylene having 1 or 2 carbon atoms".

(Office Action, page 5.)

Solely to expedite prosecution of the application, and not in acquiescence with the Examiner's assertion, claims 1 and 2 have been amended to delete the language that W¹ represents "doubly attached dioxyalkylene having 1 or 2 carbon atoms."

Based on the forgoing amendments to claims 1 and 2, the present claims 1, 2, 4 and 12-17 claims do not "encompass overlapping subject matter" of the '169 patent, and are not obvious over claims 1-4 and 7-8 of the '169 patent. Applicants respectfully request that this rejection be reconsidered and withdrawn.

B. Provisional Double Patenting Rejection

Claims 1, 2 and 4 are provisionally rejected on the ground of non-statutory double patenting over claims 15-26 of co-pending Application No. 10/538,242; claims 1-4 of co-pending Application No. 10/579,033; claims 1-4 of co-pending Application No. 10/597,723; and claims 1-4 of co-pending Application No. 12/097,753.

Applicant will address these provisional non-statutory double patenting rejections when the claims of the present application or the relevant claims of any one of the co-pending applications are allowed.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Lei Zhou
Attorney for Applicants
Registration No. 48,291

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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